

REMARKS

Upon entry of this Amendment, claims 22-42 remain pending and under current examination. In the Office Action¹, the Examiner took the following actions:

- (1) objected to the drawings;
- (2) objected to claims 22, 24, 28, 32, 36, and 37 because of alleged informalities;
- (3) objected to claims 41 and 42 under 37 C.F.R. § 1.75(c);
- (4) objected to claims 41 and 42 because of alleged informalities;
- (5) rejected claims 22-42 under 35 U.S.C. § 101, in view of *In re Bilski*, as being directed to non-statutory subject matter; and
- (6) rejected claims 22-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0123354 ("Nowak") in view of U.S. Patent No. 7,295,960 ("Rappaport").

Applicants respectfully traverse these objections and rejections for the following reasons.

Objection to the Drawings:

The Office Action objected to Fig. 1-4 and indicated that these figures "should be designated by a legend such as --Prior Art-- because only that which is old is illustrated." Office Action, p. 2. Applicants respectfully traverse this objection at least because Figs. 1-4 are not prior art. Instead, Figs. 1-4 are discussed as part of the "detailed description of preferred embodiments" on p. 6, l. 21 to p. 7, l. 25 of the Specification. This is also evident from the "brief description of the annexed drawings" discussed p. 5, ll. 16-28. Therefore, Applicants respectfully request withdrawal of this objection.

Objection to Claims 22, 24, 28, 32, 36, and 37:

The Office Action objected to claims 22, 24, 28, 32, 36, and 37 because of "mis-spelled words 'optimised', 'analysed', and 'characterised' etc." Office Action, p. 2. In response,

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Applicants first note that these words are acceptable British English spelling. Nevertheless, Applicants have amended claims 22, 24, 28, 32, 36, and 37 to correct the informalities, and accordingly respectfully request withdrawal of this objection.

Objection to Claims 41 and 42 under 37 C.F.R. § 1.75(c):

The Office Action objected the claims 41 and 42 under 37 C.F.R. § 1.75(c) “as being in improper form because a multiple dependent claim[] can not depend on another multiple depend[ent] claim (note claim 5).” Office Action, p. 3. Applicants respectfully traverse this objection, and point out that claim 5 was previously cancelled in the Preliminary Amendment filed on February 1, 2006, and therefore no claims under current examination depend from claim 5. Claims 41 and 42 thus fully comply with 37 C.F.R. § 1.75(c), and Applicants respectfully request withdrawal of this objection.

Objection to Claims 41 and 42:

The Office Action objected to claims 41 and 42 because of alleged informalities. *See* Office Action, p. 3. The Office Action states that “[a] cellular communication network ...’ should [be] change[d] to ‘the cellular communication network....’” Office Action, p. 3. Applicants respectfully traverse this objection and point out that Office Action’s suggested amendments to claims 41 and 42 are not necessary and may not be proper. *See* M.P.E.P. §§ 2173.05(e) and 2173.05(f). Particularly, the examples discussed in M.P.E.P. § 2173.05(f) illustrate the that language of claims 41 and 42 is acceptable. Therefore, Applicants respectfully request withdrawal of this objection.

Rejection of Claims 22-42 under 35 U.S.C. § 101:

The Office Action rejected claims 22-42 under 35 U.S.C. § 101 “as not falling within one of the four statutory categories of invention” and “in view of the In re Bilski decision.” Office Action, pp. 3-4. Moreover, “the Examiner suggests amending at least one step in [the] claim[s]

to positively recite the statutory item or device (mobile, device, base station, controller[,] etc.) that performs the step in order to [tie] the process to a particular statutory category.” Office Action, p. 4.

In response to this rejection, and without conceding to the Office Action’s allegations regarding non-statutory subject matter, Applicants amended claim 22 to recite a method implemented using a computer. Applicants submit that this amendment overcomes the 35 U.S.C. § 101 rejection, and accordingly respectfully request its withdrawal.

Rejection of Claims 22-42 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 22-42 under 35 U.S.C. § 103(a) as being unpatentable over Nowak in view of Rappaport.

The Office Action has not properly resolved the *Graham* factual inquiries, as required to establish a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007). In particular, the Office Action has not properly determined the scope and content of the prior art, at least because the Office Action incorrectly interpreted the content of Nowak. Specifically, Nowak does not teach or suggest what the Office Action attributes to Nowak. In addition, the Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because the Office Action has not interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

Nowak does not teach or suggest at least Applicants’ claimed “step of defining at least one cost function to be optimized, said at least one cost function being indicative of the quality of service of at least one class of services rendered by the network,” as recited in claim 22

(emphasis added). The Office Action alleged that Nowak teaches the above-quoted element by citing pars. [0008] and [0010-0016] of Nowak. *See* Office Action, p. 5.

Applicants respectfully disagree, and point out that the Office Action mischaracterized Nowak. For example, Nowak discloses “[a] method and apparatus for managing the selection of location information sources (e.g., position determining equipment sites) to provide location information for a mobile communication unit.” Nowak, Abstract. Nowak’s method “allows a requesting party to request location information that is specifically tailored to its needs.” Nowak, par. [0008]. For example, some requesting parties may request “highly accurate geographical information,” while other requesting parties may request “location information that has less geographical granularity, which may be older and have a lower cost to the request part[ies]” (emphasis added). *Id.* It is clear that the “cost” in Nowak refers to price or money to be paid. *See, e.g.,* Nowak, pars. [0010], [0013], [0015], [0035], [0037], etc.

In contrast, Applicants’ claim 22 recites a “cost function,” which is clearly defined in the originally filed specification at p. 8, equation 1. That is, Applicants’ claimed “cost function” is “characterised by merit functions for voice, data and location services” and “point[s] out a merit value (e.g. QoS) as some combination of other related parameters.” Specification, p.8, ll. 4-13 (emphases added). In other words, Applicants’ claimed “cost function” is a “function” related to a merit value which determined by input parameters. The claimed “cost function” has nothing to do with the “cost” disclosed in Nowak. In fact, Nowak does not teach or suggest anything about a “cost function” in its entire disclosure.

Rappaport does not cure the deficiencies of Nowak. For example, Rappaport discloses a method “for determining optimal or preferred configuration settings for wireless or wired network equipment in order to obtain a desirable level of network performance.” Rappaport, Abstract. Rappaport does not teach or suggest anything about “step of defining at least one cost

function to be optimized, said at least one cost function being indicative of the quality of service of at least one class of services rendered by the network," as recited in claim 22.

Thus, the Office Action has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the prior art and the claimed invention. In view of the reasoning presented above, Applicants therefore submit that independent claim 22 is not obvious over Nowak and Rappaport, whether taken alone or in combination. Independent claim 22 should therefore be allowable. Dependent claims 23-42 should also be allowable at least by virtue of their respective dependence from base claim 22. Accordingly, Applicants request the withdrawal of the 35 U.S.C. § 103(a) rejection.

Conclusion:

Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 22-42 are in condition for allowance, and Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

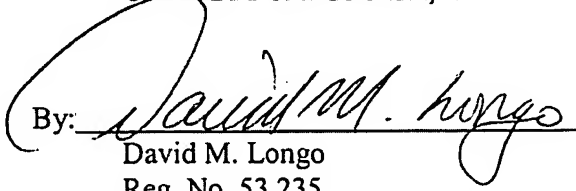
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 15, 2009

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